

### Remarks

In the office action mailed October 1, 1999, the Examiner rejected all of the claims, claims 1-4, as obvious over Yamamoto et al., in view of either Meyer or Naruo, and Norton.

Applicant believes that claim 8 was still pending. Because claim 8 is drawn to a non-elected group, Applicant has canceled claim 8, without prejudice.

### Section 103(a) rejection of Claims 1-4

The Examiner has failed to establish a motivation for combining the teachings of Yamamoto et al. with either Meyer or Naruo and Norton. It is fundamental that to establish a prima facie case of obviousness, the Examiner must show some suggestion or motivation to combine the teachings of two references. See In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). In this case, the Examiner has failed to meet that burden.

Yamamoto et al. discloses a method of forming a paper-like polyester sheet having an enhanced filter property, an excellent mechanical strength, and satisfactory touch and appearance. See Abstract. As the Examiner has recognized, Yamamoto et al. does not, however, disclose forming spacers in the sheet or calendaring the sheet in a single calendaring step to form the spacers.

The Examiner cites Meyer and Norton for the proposition that pleated filter sheets are well known in the filter art, and that the advantages of the pleated filter are obvious. The Examiner suggests that this provides sufficient motivation to combine the teachings of Yamamoto et al. and Meyer or Norton and Naruo, and that these references make up for the deficiencies of Yamamoto et al.

Contrary to the Examiner's assertion, however, Yamamoto et al. clearly teaches away from Applicant's invention. Claim 1 requires a step of calendaring the fibers. Calendaring

the fibers naturally crimps some of the fibers. Yamamoto et al. teaches that crimping is undesirable. Yamamoto et al. provides several examples of its resultant products. In some of the examples, the paper-like polyester sheets were subjected to a crimping process. Yamamoto et al. discusses the results of the crimping process, and teaches that the results of the crimping process are inferior to other uncrimped examples.

Table 2 clearly shows that in Examples 11 and 12, the crimped fibers resulted in inferior tensile strength, ultimate elongation and coefficient of air flow resistance to those in Example 10 in which non-crimped fibers were used. Also, in Example 10, the resultant [uncrimped] paper-like sheet exhibited a satisfactory air-permeability.

Col. 7, line ~55 - Col. 8 line 2. Thus, while Yamamoto may teach that the fibers can be crimped, it clearly teaches that the crimping is undesirable. Therefore, Yamamoto teaches that the calendering process (which naturally crimps some fibers) is undesirable. One skilled in the art at the time the invention was made would therefore have no motivation to process the product made by Yamamoto in the manner taught by either Meyer or Norton and Nauro. Therefore, one skilled in the art at the time the invention was made would have no motivation to combine the teachings of the cited references.

The Examiner has stated that in light of the teachings of Yamamoto, "there is a reasonable expectation of success in forming an effective corrugated filter." The Examiner has pointed to Example 11 of Yamamoto et al. to bolster that assertion, stating that "[t]he results of example 11, which illustrates a filter material using mechanically crimped fibers having about 1 crimp/inch," produces a filter within the parameters that Yamamoto et al. states is acceptable. The Examiner then concludes that because Yamamoto et al. teaches that the produced filter is *acceptable*, Yamamoto et al. teaches that the produced filter is *desirable*.

Merely showing that references *may* be combined does not satisfy the Examiner's burden. The Examiner must also show that the combination is desirable. See In re Mills, 916 F.2d 680, 682 (Fed. Cir. 1990) (Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so."). In this situation, Yamamoto et al. clearly teaches that


the proposed combination would result in an inferior product. While one skilled in the art may have concluded from reading Yamamoto et al. that the filter would work, one skilled in the art would have had no motivation to produce the filter that Yamamoto et al. teaches is inferior. Therefore, the Examiner has failed to establish that there is a motivation for combining the cited references, and has failed to establish a prima facie case of obviousness.

For the foregoing reasons, withdrawal of the rejection of claims 1-4 is respectfully requested. Notice of allowance is now in order.

Dated:

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